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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,913	11/30/2000	Siddhartha R. Dalal	APP 1225-US	2156
9941	7590	05/03/2004	EXAMINER	
TELCORDIA TECHNOLOGIES, INC. ONE TELCORDIA DRIVE 5G116 PISCATAWAY, NJ 08854-4157			WILLETT, STEPHAN F	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 05/03/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

224

# Office Action Summary

Application No.

09/726,913

Applicant(s)

DALAL ET AL.

Examiner

Stephan F Willett

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC 102***

1. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-6, 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogle et al. with Patent Number 6,654,790.

3. Regarding claim(s) 1, 6, Ogle teaches a presence processor, col. 6, lines 12-15. Ogle teaches an [instant] messenger client (IM) connected to said processor, col. 6, lines 29-30. Ogle teaches a unified instant messaging processor communicating with said processor and users, col. 6, lines 35-36. Ogle teaches means for storing user defined terminal selections, col. 7, lines 34-37 and user preferences, col. 7, lines 46-49. Ogle teaches a further processor comprising reporting means for receiving information as to the user defined local presence states, i.e. logged on or off col. 7, lines 11-13, and/or message data, col. 7, lines 10-11 and means for formatting, col. 9, lines 53-54 and routing data, col. 9, lines 39-40.

4. Regarding claim(s) 2, Ogle teaches formatting and routing message data, col. 9, lines 55-57. Ogle teaches formatting and routing presence data, col. 7, lines 20-21, 28-31.

Art Unit: 2141

5. Regarding claim(s) 3, Ogle teaches a protocol interface between processors, col. 5-7, lines 62-6, col. 9-10, lines 66-2 wherein the IMS and EMS convert between protocols using associated conversion or transformation engine.
6. Regarding claim(s) 4, Ogle teaches communication between processors and clients is over the Internet, col. 6, lines 58-59.
7. Regarding claim(s) 5, Ogle teaches a messaging processor is a central server, col. 6, lines 66-67 for a plurality of users with terminals, col. 5, lines 28-30.
8. Regarding claim(s) 10, Ogle teaches registering with the processor on behalf of the user, col. 7, lines 43-46.
9. Regarding claim(s) 11, Ogle teaches the processor prompting a user for a local state as “chooses” to “register”, col. 7, lines 35-37 with reporting the user state, col. 10, lines 20-21 as “available delivery mechanisms” and delivery said state information to buddies, col. 10, lines 21-22 as presenting them to the sender or buddy.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable Ogle et al. with Patent Number 6,654,790 in view of Maurille with Patent Number 6,484,196.

Art Unit: 2141

12. Regarding claim(s) 7, Ogle teaches a presence processor, col. 6, lines 12-15. Ogle teaches an [instant] messenger client (IM) connected to said processor, col. 6, lines 29-30. Ogle teaches a unified instant messaging processor communicating with said processor and users, col. 6, lines 35-36. Ogle teaches means for storing user defined terminal selections, col. 7, lines 34-37 and user preferences, col. 7, lines 46-49. Ogle teaches a further processor comprising reporting means for receiving information as to the user defined local presence states, i.e. logged on or off col. 7, lines 11-13, and/or message data, col. 7, lines 10-11 and means for formatting, col. 9, lines 53-54 and routing data, col. 9, lines 39-40. Ogle teaches the invention in the above claim(s) except for explicitly teaching a similar reply response to forwarded message. In that Ogle operates to forward data in a computer network, the artisan would have looked to the network data forwarding arts for details of implementing resultant details of forwarding messages. In that art, Maurille, a related network data forwarding communication system, teaches "message replier", col. 15, line 66 in order to provide relevant message forwarding. Maurille specifically teaches "these fields are filled in with the sender's information", col. 16, lines 8-9. Further, Maurille suggests "the reply includes the MsgId of the message responded to", col. 16, lines 15-16 for correlation which will result from implementing the IM forwarding. The reply message will be monitored the same as the original message and correlated the message to the sender and translating and delivering the reply the same as described above in Ogle. The motivation to incorporate replies insures the forwarding is not just a one way process. Thus, it would have been obvious to one of ordinary skill in the art to incorporate replies as taught in Maurille into the communication system described in Ogle because Ogle operates with forwarding all messages including replies and Maurille suggests that optimization can be

Art Unit: 2141

obtained by specifically forwarding reply messages. Therefore, by the above rational, the above claims are rejected.

13. Regarding claim(s) 8, Ogle teaches the communication via email col. 7, line 39.

14. Regarding claim 9, the Ogle patent discloses the method of the preceding claims and Maurille teaches "the reply includes the MsgId of the message responded to", col. 16, lines 15-16 for correlation of addresses and sessions. The Ogle patent does not explicitly disclose using SMTP. However, Official Notice is taken MPEP 2144.03 (a)) that using SMTP is well known in the art to insure a reliable and defined protocol is used. It would have been obvious to one of ordinary skill in the art at the time of the application's invention to use SMTP to obtain the advantages of communicating with compatible protocols. By the above rational, the claim is rejected.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. The other references cited teach numerous other ways to IM forwarding, thus a close review of them is suggested.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (703) 308-5230. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia, can be reached on (703) 305-4003. The fax phone number for the

Art Unit: 2141

organization where this application or proceeding is assigned is (703) 872-9306.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9605.

A handwritten signature in cursive script, appearing to read "Stephan Willett".

Stephan Willett

Patent Examiner

April 28, 2004